

## **REMARKS**

### **CLAIM REJECTIONS – 35 USC 103**

Claims 1-23 have been rejected as being obvious over Tangen in view of Okayama. Applicant respectfully traverses the Examiner's rejection on the merits, but Applicant believes that arguments in support of such traversal are moot because Okayama cannot be used as a prior art reference in view of the following.

The current application was filed on August 30, 2006 as U.S. National Phase Application (under 35 USC 371) of PCT/US05/008727 ('727 PCT). The '727 PCT application (filed March 16, 2005) claims foreign priority to Swedish Application 0400674-8<sup>1</sup>, which was filed on March 17, 2004. Therefore, March 17, 2004 is the earliest priority date for the current application.

The Okayama reference was filed on May 4, 2006 as a U.S. National Phase Application of PCT/JP04/16332 ('332 PCT). The '332 PCT was filed on November 4, 2004 and it claims priority to two Japanese applications – JP 2003-374724 and JP 2004-194195 filed November 4, 2003 and November 30, 2004 respectively.

The earliest date that the '332 PCT is available as a reference<sup>2</sup> is as of the filing date of the international application – i.e. November 4, 2004. Applicant's priority date of March 17, 2004 therefore predates the earliest date that Okayama is available as a prior art reference.

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<sup>1</sup> Swedish Application 0400674-8 issued as a patent in Sweden.

<sup>2</sup> Applicant does not concede that the '332 is available as of the stated date. Applicant merely points out what the earliest *possible* date Okayama could be cited as prior art under the law.

The Examiner is respectfully directed to MPEP 2136.03, which states:

**35 U.S.C. 102(e)** is explicitly limited to certain references "filed in the United States before the invention thereof by the applicant" (emphasis added). Foreign applications' filing dates that are claimed (via 35 U.S.C. 119(a) - (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C. 102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. In contrast, applicant may be able to overcome the 35 U.S.C. 102(e) rejection by proving he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the reference's U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966) (*Hilmer I*) (Applicant filed an application with a right of priority to a German application. The examiner rejected the claims over a U.S. patent to Habicht based on its Swiss priority date. The U.S. filing date of Habicht was later than the application's German priority date. The court held that the reference's Swiss priority date could not be relied on in a 35 U.S.C. 102(e) rejection. Because the U.S. filing date of Habicht was later than the earliest effective filing date (German priority date) of the application, the rejection was reversed). See MPEP § 201.15 for information on procedures to be followed in considering applicant's right of priority.

In view of the above, where the prior art reference that pre-dates a U.S. filing date is a foreign application (the JP applications) and it is claimed via 35 USC 365(a) (the '232 PCT), such reference may not be used as 35 USC 102(e) dates for prior art purposes.

It should be noted that Applicant does not make any assertions regarding the substance of the above-mentioned JP applications other than to note that they are not available as a reference.

In light of the above, Applicant believes that the application is now in condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Rotberg', with a long horizontal flourish extending to the right.

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